REMARKS

The Examiner's attention to the present application is noted with appreciation.

Background and New Action

The Examiner issued a final office action on July 15, 2008. Applicant filed a notice of appeal and appeal brief in response to the final office action. The Examiner withdrew the application from appeal and issued a non-final office action on February 23, 2009.

The Examiner rejected claims 1, 6-8, 11-15, 18, 21, 22, 25, 29-33, 35-43, and 45-52 under 35 U.S.C § 103(a) as being unpatentable over Edson (306,727) or Rombauer et al. (page 564), in view of cited references in Applicant's specification, and further in view of Cammarn et al. (5,417,999) and still further in view of Avera (3,615,590), and still further in view of Stockton (1,395,934), and yet still further in view of Yokoyama et al. (4,814,195). This rejection is traversed.

The previous rejection, which was the basis for the appeal, was for claims 1, 6-8, 11-15, 18, 21, 22, 25, 29-33, 35-43, and 45-52. These claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Edson in view of the prior art (specification page 7, lines 15-22) and Cammarn et al. and Avera and Stockton and further in view of Rombauer. Thus, the Examiner's new rejection adds yet another reference, namely Yokoyama et al. All of the Examiner's arguments remain the same with exception to a new argument based on Yokoyama et al. in combination with the other references.

In rejecting Applicant's claims, the Examiner relies on the combination of six different references! In so doing, the Examiner is forced to combine references that teach away not only from each other, but which also teach away from Applicant's claimed invention. Surely, an invention is not obvious when the Examiner has to use six references in order to make a rejection. And, indeed, the non-obviousness of Applicant's invention is discussed below.

Applicant's claims recite a process having a coarse consistency paste with nut particles in a size ranging from about 1.5 to about 3.5 mm and not containing hydrogenated oils, not containing an emulsifier, not containing stabilizers and not containing a bulking agent. The cited references either alone

or in combination do not teach or render obvious this invention. Each of the references is discussed below.

Edson

In the office action dated February 23, 2009, the Examiner argues on page 2, last paragraph that "Edson discloses a process of making a peanut paste by roasting peanuts and grinding the peanuts as in claim 1 and 19." Claim 19 is canceled so Applicant will assume the Examiner meant claim 14.

However, Edson fails to disclose or even mention grinding the roasted nuts to a coarse consistency paste having nut particles ranging in size from about 1.5 to about 3.5 mm to produce a nut butter as recited in Applicant's independent claims.

The Examiner also argues that "Edson discloses Applicant's process and does not require any of the ingredients or processes, which are not required as in claims 1". We note that Edson, entitled "Manufacture of Peanut Candy", discloses a process of making a peanut candy using one part peanut-paste and seven parts sugar (see Edson lines 44-46). Edson also discloses using flour or fluids which are considered bulking agents (see Edson Col. 1, lines 38-39). Thus, Edson teaches away from Applicant's claims which recite, "a nut butter [or nut butter spread]...not containing a bulking agent."

The Examiner states on page 8 of the office action that "[t]he 'flour' applicant is referring to is not part of the invention in the patent, but is made if the peanuts are ground cold on a mill which results in peanut flour, which is not what they are doing, but as claimed in the reference, the invention was to roasting on heated surfaces". It is not clear what the Examiner is trying to argue. Edson clearly discloses the use of flour. For example, Edson states "[the peanut paste] will again become fluid by raising its temperature to about 100° Fahrenheit, and in this liquid form is easily mixed or compounded with flour or fluids" (see Edson lines 36-39). The Examiner cannot limit what is taught by a reference. See MPEP § 2123(I). The reference must be taken as a whole and cannot be broken into pieces. For example, one skilled in the art after reviewing this entire reference would learn that a bulking agent, flour, is at least sometimes added to Edson's fluid peanut paste. Both Edson's intermediate step and final step, namely

the liquid form of the peanut paste and the peanut candy comprising flour, teach away from Applicant's claimed invention.

Rombauer

The Examiner also rejected Applicant's claims under Rombauer, stating on page 2, last paragraph, "Rombauer discloses a process of making peanut butter by roasting and grinding nuts in amounts over 90% with oil (page 564, under "Peanut Butter") (claims 31, 32)". Rombauer is an excerpt from *Joy of Cooking* and fails to teach any of the elements of Applicant's recited claims. In fact, Rombauer's entire disclosure only teaches that federal regulations require commercial peanut butter to contain 90% shelled roasted ground peanuts and that one can make their own peanut butter in an electric blender. Rombauer fails to disclose grinding nuts to a coarse consistency paste, fails to disclose a nut particle size and fails to disclose a nut butter or nut butter spread not containing hydrogenated oils, stabilizers, an emulsifier or a bulking agent as recited in Applicant's claims. Rombauer simply discloses how commercial peanut butters are made without the germ of the nut.

The Examiner then argues that, "[n]othing has been shown that grinding as in Rombauer would have not produced the claimed particle size". However, Rombauer fails to suggest, disclose or even mention grinding to a coarse consistency paste with particular particle sizes. Then the Examiner admits that Rombauer differs from Applicant's claim 1 "in the step of grinding to a coarse paste with a particular particles size". See the bottom of page 2 of the office action.

Yokoyama et al.

The Examiner attempts to use Yokoyama et al. to remedy just one of many of the deficiencies of Edson and Rombauer, namely particle size. Specifically, the Examiner states on the top of page 3 that "Yokoyama et al. disclose a peanut butter, which uses 1/8 inch peanut particles in a chunky peanut butter, which is within the claimed particle size". However, the 1/8 inch peanut bits of Yokoyama et al. are "incorporated into a smooth peanut butter-type base" (see Yokoyama et al., Col. 9, lines 44-46). The

peanut bits in Yokoyama et al. are added to an already smooth peanut butter. The bits are not a coarse consistency paste used to produce the nut butter and nut butters spreads as recited in Applicant's independent claims. Yokoyama et al. differ from Applicant's recited claims since the peanut butter as taught by Yokoyama et al. has a smooth consistency, and Applicant's recite grinding nuts to a coarse consistency paste. Simply adding peanut bits to a smooth peanut butter base fails to teach grinding nuts to a particular nut size to create a coarse nut paste. While Applicant's claimed nut particles produce the nut butter or nut butter spread, Yokoyama et al. disclosed peanut particles are added to a finished peanut butter to make the peanut butter "crunchy".

Further, Yokoyama et al. teach that "the reduction in calories is achieved by adding one or more non- or low-calorie solid bulking agents, such as polydextrose or microcrystalline, to the peanut butter" (see Yokoyama et al., Col. 2, lines 64-68). The bulking agents disclosed in Yokoyama et al. account for 15% to 40% by weight of the disclosed peanut butter (see Yokoyama et al., Col. 2, line 68 to Col. 3, line 1). Thus, Yokoyama et al. teach the opposite of a nut butter not containing a bulking agent as recited in Applicant's claims since the peanut butter disclosed in Yokoyama et al. contains a large amount of bulking agents. This is a very typical type of peanut butter one will find in the supermarket, and is not Applicant's invention.

The Examiner attempts to combine Applicant's specification, Cammarn et al. and Avera to remedy the deficiencies of Edson combined with Yokoyama et al. or Rombauer combined with Yokoyama et al. Each of these references is discussed below.

Applicant's Specification

The Examiner states, "Applicant's specification on page 7, lines 15-21 discloses that it is known to make natural peanut butters without adding hydrogenated fats or emulsifiers." However, the Examiner failed to note the most important following sentence in the specification on page 7, lines 19-21, which states when referring to the peanut butters in the references, as follows: "The resulting peanut butter . . . exhibits gravitational instability, i.e., oil separation on the top of the product." Applicant's invention does

not have such oil separation on top of the product because of its coarse grinding and specific particle size. The Examiner does admit that none of the references disclose a nut butter or nut butter spread made from a coarse consistency paste. These natural peanut butters teach away from Applicant's invention. Applicant's specification then goes on (pages 8-9) to describe how stabilizers, emulsifiers and bulking agents are added to these cited peanut butters.

Cammarn et al.

Cammarn et al. teach a system which relies on a stabilizer, "the peanut butters or spreads of the present invention preferably comprise from about 1% to about 5% by weight of a stabilizer" (see Cammarn et al., Col. 3, lines 16-18). Cammarn et al. also teach the use of an emulsifier. For instance, Cammarn et al. state, "the peanut butters of the present invention can contain an emulsifier" (see Cammarn et al., Col. 3, lines 34-36). Because Applicant's amended independent claims recite "the process not containing stabilizers" and "the process not containing emulsifiers", Cammarn et al. teach away from Applicant's claimed invention.

Avera

Avera teaches the use of stabilizers. For example, "it is desirable to add to the slurry, prior to roasting, a material that functions as a stabilizer" (see Avera Col. 1, lines 69-71). Avera also teaches the use of hydrogenated oils. Avera states, "[a]ny compatible high melting fat component may be used as the stabilizer...a partially hydrogenated fat, a completely hydrogenated fat, mono (and di-) glyceride esters of the saturated fatty acids, or mixtures of these firming-up agent" (see Col. 6, lines 12-18). Therefore, Avera clearly teaches away from Applicant's recited claims.

Avera further teaches away from Applicant's claimed invention of using coarse ground roasted nuts by relying on the use of blanched nuts (see Avera Abstract). The additional step of blanching nuts not only significantly increases the cost and complexity of the overall process, but can also break apart some nuts and then results in a portion of the raw materials being discarded, and thus wasted. Because

Applicant's invention teaches away from the increased costs, complexity, and wastefulness associated with blanching the nuts, and because it is believed that Applicant's use of roasted nuts helps reduce residual natural oils released from grinding the nuts, Applicant's claims are directed to the use of roasted nuts. Avera thus teaches away from Applicant's claimed invention, which uses unblanched nuts.

Further, Avera adds chunks of peanuts to a slurry for crunchy peanut butter. This teaches away from Applicant's nut particle size since Avera first grinds the nut butter to a fluid slurry (see Avera, Col. 1, line 13 and Col. 2, lines 65-67) and then later adds chunks to make the nut butter crunchy (see Avera, Col. 6, ones 45-50). Applicant simplifies the process by grinding to a coarse consistency and thus does not require adding nut chunks after the grinding step.

The Examiner argues that "Avera was used for the teaching that roasting develops flavors and that grinding develops a temperature of about 160° F". See Page 9, second paragraph of the present office action. However, the Examiner cannot pick and choose what is taught in a specific reference. "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain". See MPEP § 2123(I). The entire reference must be considered for all it contains. In this case, Avera teaches using a stabilizer, a hydrogenated oil, blanched nuts and a fluid slurry. All of these elements, as taught in Avera, teach away from Applicant's independent claims.

Stockton

The Examiner next offers Stockton to remedy the deficiencies of the combination of Edson or Rombauer, Yokoyama et al., Cammarn et al. and Avera. The Examiner specifically states on page 3 of the office action, "Stockton discloses that the degree of oil separation can be prevented partially by coarse grinding, that the finer the grinding the more pronounced the tendency to gravitational separation (page 1, lines 89-103)". However, what Stockton actually discloses at the portion cited is:

> [t]his difficulty of oil separation being foreseen may in only a very partial degree be prevented by coarse grinding; for the finer the grinding of the kernels the more pronounced the tendency to gravitational separation. But coarse ground peanut butter is less desirable. It is mealy and does not spread well, and furthermore it is less

> readily digested than fine ground butter. Another expedient that has been resorted to, to prevent in some measure this gravitational separation is to diminish the value of the fraction of oil in the mass. . .".

Thus, not only does Stockton teach away from coarse grinding to control oil separation, but Stockton also teaches away from Applicant's claimed invention by denouncing coarse grinding and graphically describing the less than desirable results that are associated with Applicant's coarse grind.

Stockton, at columns 5 and 6, goes into great detail about how that invention relies on hydrogenated oils and/or other stabilization oils to prevent separation of the peanut oil from the peanut solids. Accordingly, Stockton relies upon a principal problem which Applicant's invention seeks to address. The use of hydrogenated oils and/or other stabilization oils is thus the antithesis of Applicant's claimed invention. Further, Stockton fails to give any examples of nut particle sizes as recited by Applicant's amended claims.

The Examiner states, "Stockton is used only for the teaching that the degree of oil separation can be prevented partially by coarse grinding, that the finer the grinding the more pronounced the tendency to gravitational separation (page 1, lines 89-103). Even if the reference teaches away, the concept is known". However, the Examiner again is picking and choosing particular portions of a reference and stating that the other portions of the reference do not count for what they teach. Again, the entire patent must be reviewed for what it teaches as a whole. See MPEP § 2123(I). The entire reference must be considered for all it contains. In this case, Stockton teaches using hydrogenated oil and/or stabilization oils and the desire for a smooth and not coarse nut butter. These teachings clearly teach away from Applicant's independent claims. Further, it would not be obvious to one skilled in the art to choose a portion of Stockton's disclosure that actually teaches away from Applicant's coarse consistency nut paste and use it to produce a new nut butter.

Bolton

The Examiner in rejecting claim 5 attempts to combine all the cited references, and further adds Bolton. Claim 5 recites blending at least one ingredient selected from the group consisting of spices,

herbs, dried fruits, extracts of the same, salt and sugar, with the nut paste during grinding. The Examiner states on the bottom of page 7 of the office action that "Bolton discloses that it is known to add cucumbers to peanut butter (col. 1, lines 12-50). Therefore, it would have been obvious to add known ingredients to the peanut paste in the process of the combined references." However, Applicant is not adding cucumbers to the nut paste. Thus, Bolton fails to disclose any element recited in Applicant's claim 5.

Bolton teaches a food product comprising a nut butter with water and cut up cucumber pickles (Bolton lines 84-86). Bolton also teaches having a food product with a consistency of cheese or heavy jelly, which teaches away from Applicant's claimed nut particle size. Thus, Bolton teaches away from Applicant's recited claims by teaching adding water to a nut butter as well as adding cucumber pickles to the nut butter.

Improper Combination

The references cited by the Examiner are an improper combination. As illustrated above, many of the references teach away from each other. For example, Rombauer's peanut butter that is at least 90% peanuts could not be combined with Yokoyama et al. since the peanut butter disclosed in Yokoyama et al. contains 15 to 40% by weight bulking agent (see Yokoyama et al. Co. 2, line 68 to Col. 3, line 1). Edson's peanut candy could not be combined with the "crunchy" peanut butter of Yokoyama et al. since Edson's peanuts are required to be in a fluid or semi-fluid state (see Edson lines 29-32). Bolton could also not be combined with Rombauer since Bolton adds cucumber pickles to a nut butter. Further, Avera uses blanched nuts while Cammarn et al. teaches the opposite, using unblanched white-skinned peanuts. Thus, one skilled in the art would not combine the cited references since many of them teach away from each other and some even teach opposite elements.

Summary

None of the cited references disclose grinding roasted nuts to a coarse consistency paste having nut particles ranging in size from about 1.5 to about 3.5 mm to product a nut butter or nut butter spread.

Further, all but one of the references teach away from Applicant's claims since the products contain at least one hydrogenated oil, emulsifier, stabilizer and/or bulking agent. For example, Edson uses flour or fluids which are considered bulking agents (see Edson Col. 1, lines 38-39). Yokoyama et al. use a large amount of bulking agents (see Yokoyama et al. Col. Abstract). Cammarn et al. use soybean and rapeseed hardstock as stabilizers (see Cammarn et al. Col. 4, line 46). Avera uses lightly hydrogenated or hardened oil as stabilizers (see Avera Col. 2, line 56). Stockton also uses hydrogenated oils as stabilizers (see Stockton Col. 5, line 65 to Col. 6, line 3). All but one of the cited references relied on by the Examiner contain ingredients which Applicant's recited claims do not have. Rombauer is the only reference that does not contain an ingredient that is also not in Applicant's recited claims. However, Rombauer's entire disclosure only teaches that federal regulations require commercial peanut butter to contain 90% shelled roasted ground peanuts and that one can make their own peanut butter in an electric blender.

In addition, none of the cited references cited by the Examiner specify or even mention ranges of nut particle size. Even if particle size were disclosed or inherent in one or more of the cited references, the particle size range recited by Applicant would not be the particle size of the cited references. In other words, the cited references would not utilize the same particle size as Applicant. For instance, Edson teaches peanuts that are "ground into a fluid or semi-fluid state, having a consistency of rather thick or heavy molasses or cream" (see Edson lines 29-32). Thus, a nut particle size in Edson would not be nearly as large as Applicant's 1.5 to 3.5 mm particle size. Yokoyama et al. disclose that larger particle sizes are perceived as imparting grittiness to peanut butter products, an especially undesireable feature for a food product that ideally is smooth in texture (see Yokoyama et al. Col 3 line 65 to Col. 4, line 1). Therefore, Yokoyama et al. teach away from the large particle size range recited in Applicant's claims. Further, Avera discloses that a "slurry is passed through a fine mill 12, that grinds the solids to a sufficiently small size to make a smooth product. It is preferably ground so that at least 96 percent will pass through a standard U.S. sieve of 200 mesh size" (see Avera Col. 2, lines 65-68). Applicant's nut particle size range of 1.5 to 3.5 mm could not pass through a sieve of 200 mesh size (0.076 mm).

Stockton teaches that "ordinarily, fine grinding is preferred" (see Stockton lines 59-60), thus teaching away from the coarse grinding of Applicant's recited claims. Therefore, all of the cited references disclose a nut particle size that is much smaller than the nut particle size recited by Applicant.

The Examiner states that "the various references were used in combination for what was cited in the office action and for teachings that show that it would have been obvious to make a composition as application has done". However, the various references must be taken as a whole and cannot be taken for teaching just bits and pieces of each one. None of the references cited by the Examiner teach "the resulting nut butter spread not containing hydrogenated oils; the resulting nut butter spread not containing stabilizers; the resulting nut butter spread not containing an emulsifier; and the resulting nut butter spread not containing a bulking agent" as recited by Applicant's independent claims. The references also do not render Applicant's claims obvious since all but one of the references teach using at least one of the ingredients that is not contained in Applicant's claims. The remaining reference, Rombauer, is silent as to the ingredients not contained in Applicant's claims. None of the references teaches that a hydrogenated oil and/or a stabilizer and/or an emulsifier and/or a bulking agent is not in a nut butter or nut butter spread. The Examiner cannot pick and choose what each reference teaches since clearly one skilled in the art would consider and learn from each reference as a whole. Thus, since all of the references as a whole teach away from Applicant's claims, it would not be obvious to one skilled in the art to NOT add all of the ingredients and to grind the nut paste to a coarse consistency as recited in Applicant's claims.

The references cited by the Examiner do not disclose or render obvious Applicant's claims, and teach away from Applicant's invention. Because the cited references cited by the Examiner teach away from each other, the Examiner's proposed modifications to them, in an attempt to result in Applicant's claimed invention, thus renders the cited inventions being modified unsatisfactory for their intended purpose. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Because none of the references cited by the Examiner disclose nut particle size ranges as recited by Applicant's claims; and because the individual inventive elements of Applicant's claimed invention are not all disclosed in the numerous cited references by the Examiner even in a post facto manner; and

because the cited references teach away from Applicant's invention; and because the cited references teach away from each other; and because one skilled in the art would not attempt to so combine the details of the numerous references in such a novel and non-obvious manner; and because the Examiner's combination of the numerous cited references renders them unsatisfactory for their intended purpose, the novel combination of the cited references cited by the Examiner is thus inappropriate in rejecting Applicant's claims.

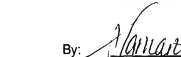
Therefore, claims 1, 14, 33 and 42 are patentable. Claims 5-8, 11-16, 18, 21, 22, 25, 29-33, 35-43, and 45-52, which are dependent on claims 1, 14, 33 and 42, are also patentable.

In view of the above amendments and remarks, it is respectfully submitted that all grounds of rejection have been traversed. It is believed that the case is now in condition for allowance and same is respectfully requested.

If any issues remain, or if the Examiner believes that prosecution of this application might be expedited by discussion of the issues, the Examiner is cordially invited to telephone the undersigned attorney for Applicant at the telephone number listed below.

The fee for additional claims is included. Authorization is given to charge payment of any additional fees required, or credit any overpayment, to Deposit Acct. 13-4213.

Respectfully submitted,

By: 

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